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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/067,825

02/08/2002

Yoji Takeuchi

8014-1007

9554

466

7590

11/21/2005

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EXAMINER

PHAN, MAN U

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. **CK**

10/067,825

Applicant(s)

TAKEUCHI, YOJI

Examiner

Man Phan

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The application of Takeuchi for the "Internet IP telephone switching system, internet-oriented IP telephone apparatus, internet IP telephone connection management method, telephone number automatic receiving/sending method, and computer readable medium on which an internet IP telephone switching program is recorded" filed 02/08/2002 has been examined. This application claims Foreign Priority based on the application 2001-075026 filed February 06, 2001 in Japan. Receipt is acknowledged of papers submitted under 35 U.S.C 119(a) – (d), which papers have been placed of record in the file. Claims 1-5 are pending in the application.

Specifications

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Appropriate correction is required.

Claim Objections

3. Claims 2 is objected to because of the following informalities:

The claims contain the phrase “capable of” (line 2). It has been held that the recitation that an element is “capable of” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

Claim Rejections - 35 USC # 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 1 12:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 are rejected under 35 U.S.C. 1 12, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1 recites the limitations “the allocation status of IP address” in line 9. There is no antecedent basis for this limitation in the claim.

b. Claim 2 recites the limitations “the IP address allocation status” in line 9 and “the program” in line 14. There is no antecedent basis for this limitation in the claim.

c. Claim 3 recites the limitations “the IP address allocation status” in line 2 and “the IP address database” in line 6. There is no antecedent basis for this limitation in the claim.

d. Claim 3 recites the limitations “the connection status” in line 21 and “the IP address column” in line 24. There is no antecedent basis for this limitation in the claim.

e. Claim 4 recites the limitations “the IP address database” in line 9. There is no antecedent basis for this limitation in the claim.

f. Claim 5 recites the limitations “the allocation status of IP address” in line 12. There is no antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC ' 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al. (US#6,424,647) in view of Umansky et al. (US#6,868,080).

With respect to claims 1-5, Ng et al. (US#6,424,647) and Umansky et al. (US#6,868,080) disclose a novel system and method for allowing access to both public telephone network (PSTN) and a computer communication network (IP), according to the essential features of the claims. Ng discloses in Figs. 1-9 and in the respective portions of the specification about the voice over internet protocol device ("internet phone terminal") capable of auto-selectively dialing up a public switched telephone network or an internet phone (For example see Figs. 1-2; the Abstract), which comprises the line transfer switch ("internet phone" or "relay" in Figs. 1-2 and 8), which connects with the terminal apparatus to receive the voice signal produced by the terminal apparatus ("phone"); a control circuit ("internet processor" in Fig. 2) is used to control each component in the entire device, and proceeds with packet processing for the signal received to produce the corresponding internet protocol packet (For example see col. 4, lines

54-64); the control circuit connecting with the line transfer switch to produce a trigger signal ("ringing signal"; For example see col. 17, lines 23-30) that causes the line transfer switch to transfer the voice signal produced by the terminal apparatus from the subscriber line interface circuit ("SLIC" in Figs. 2 and 8) to the public switched telephone network (PSTN). Wherein the subscriber line interface circuit is connected to the line transfer switch and to the control circuit and arranged to transform the voice signal transmitted from the terminal apparatus to digital signal, and then transmit the digital signal to the control circuit to proceed with packet processing (For example see col. 4, lines 54-64); the phone detection circuit ("off-hook detector" in Fig. 8), which is connected with the line transfer switch and the control circuit to detect the employment status ("on hook" in Fig. 9; it is obvious that the "off hook" position of the phone is the "unused status" of the phone) of the terminal apparatus (For example see col. 18, lines 58-62); the ringing detection circuit ("ring detector" in Fig. 8), which is connected with the line transfer switch and the loop ("position 1" in Fig. 8) to detect the in-coming call ringing signal ("ringing signal") transmitted from the public switched telephone network through the loop (For example see col. 17, lines 23-26), wherein when the in-coming call ringing signal is detected according to the employment status of the terminal apparatus detected by the phone detection circuit, the control circuit supplies an in-coming call transfer signal to cause the line transfer switch to connect the terminal apparatus with the loop to receive the ringing signal when the employment status of the terminal apparatus is unused ("on-hook state"), and when the terminal apparatus is picked up to enable communication with the remote terminal apparatus to proceed through the public switched telephone network (For example see col. 17, lines 21-64). Ng et al. further teaches in Fig. 2 a block diagram illustrated the detailed

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internet phone 103, in which the Codec 204 preferably uses a pulse code modulation (PCM) technique, which is a method of modulation in which signals are sampled and converted to digital words that are then transmitted serially. The Internet processor 206 is a high performance Digital Signal Processing (DSP) chip operable to process executable programs such as modem (*Modulation-Demodulation*) algorithms including V.80 and V.34+, speech related algorithms including G.723.1 and G.729, and acoustic echo cancellation algorithms (Col. 5, lines 15 plus).

However, Ng does not disclose expressly the switching section for switchingly connecting the telephonic function between the internet-oriented IP telephone and a PSTN telephone over the internet network. In the same field of endeavor, Umansky et al. (US#6,868,080) teaches in Figs 2, 3 detailed diagrams illustrated the functionality of the gateway, in which a switching section 24 for switchingly connecting to either the VoIP interface 25 or the PSTN telephony interface 21 (Col. 3, lines 42-50 and Col. 4, lines 7-20).

One skilled in the art would have recognized the need for facilitating the controlling of signal between telephone line signal processing and VoIP engine, and would have applied Umansky's teaching of the switching between PSTN and VoIP into Ng's novel use of the Internet phone connection. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Umansky's voice over IP call fallback for quality of service degradation into Ng's method and apparatus for making a phone call connection over an Internet connection with the motivation being to provide a method and system for controlling the access to both PSTN and VoIP system.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Itoi (US#6,456,625) is cited to show the LAN telephone switching system.

The Ng et al. (US#6,424,648) is cited to show the Method and apparatus for making a phone call connection over an internet connection

The Thornton et al. (US#6,665,293) is cited to show the application for VoIP telephony gateway and method for use therein.

The Stahl et al. (US#6,801,526) is cited to show the server for supporting the establishment of telephone calls through an IP network.

The Wilson (US#6,169,734) is cited to show the internet phone set.

The Shaharabani et al. et al. (US#US2001/0012285) is cited to show the Internet telephone interface system.

The Vaananen et al. (US2004/0013109) is cited to show the method of setting up a connection for calls.

The Zhang et al. (US2004/0090954) is cited to show method and apparatus for providing internet call waiting with VoIP.

The Dolan et al. (US2005/0207557) is cited to show the methods and apparatus for providing expended telecommunications service.

9. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

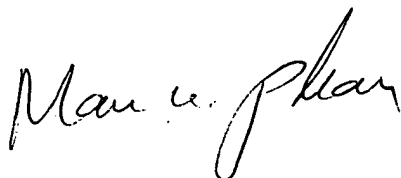
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

11/17/2005.

A handwritten signature in cursive script that reads "Man U. Phan".

**MAN U. PHAN
PRIMARY EXAMINER**